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IN THE

Supreme Court of the United States

October Term, 1955

No. [redacted] 55

MARIA LUISA DEBURGH, EXECUTRIX OF THE ESTATE OF ALBERT R. DEBURGH, DECEASED,
Petitioner,

v.

KINDEL FURNITURE COMPANY, CHARLES M. KINDEL, AND THE RAPIDS-STANDARD COMPANY, INCORPORATED,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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In The

Supreme Court of the United States

October Term, 1955

No.

Maria Luisa DeBurgh, Executrix, Estate Albert R. DeBurgh, Deceased,

Petitioner,

v.

Kindel Furniture Company, Charles M. Kindel, and Rapids-Standard Company, Inc.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

The petitioner, Maria Luisa DeBurgh, Executrix, Estate of Albert R. DeBurgh, prays that a writ of certiorari issue to the United States Court of Appeals for the Sixth Circuit to review the decision and judgment of that Court in this action.

Following the practice provided for in Rule 21 of this Court, petitioner files herewith a certified record from the Court below, including the printed Appendices of plaintiff-appellant and defendants-appellees, and the proceedings in the Court below.

OPINIONS OF THE COURTS BELOW

The United States Court of Appeals for the Sixth Circuit, on January 6, 1956, issued an order affirming the judgment of the District Court for the Western District of Michigan "in accordance with the findings of fact, conclusions of law, and for the reasons stated in the opinion of Judge Starr." That judgment had held that all twelve claims of the Albert R. DeBurgh patent No. 2,317,675 were invalid "and that the claims having been held invalid by the Court now here are not considered to be infringed."

The Court of Appeals thus affirmed and adopted as its own the findings of fact, conclusions of law, opinion, and judgment of the District Court.

The order of the Court of Appeals appears in the Appendix to this Petition at page 30 and in the certified record from the Court below. It has not been reported in the reporter system.

The opinion of the District Court, dated October 19, 1954, is printed in the Appendix to this Petition at pages 31 to 53, together with the findings of fact, conclusions of law, and judgment.

These findings, conclusions, opinion, and judgment are also printed in the record of the Court below in plaintiff-appellant's Appendix, the opinion on page 35a, the findings page 58a, the conclusions page 59a, and the judgment page 60a.

The opinion of the District Court is reported in 125 F. Supp. 468 (W. D. Mich. 1954); 103 USPQ 203.

STATEMENT OF GROUNDS ON WHICH JURISDICTION IS INVOKED

The jurisdiction of this Court is invoked on the grounds that the United States Court of Appeals for the Sixth

Circuit by its order affirming the decision of the District Court has decided an important question of Federal law which has not been, but should be, settled by this Court, which decision is in direct conflict with an applicable decision of the United States Court of Appeals for the Second Circuit (certiorari recently denied by this Court) involving the same basic principle of law.

More specifically, this Court is asked to settle a direct conflict relating to the interpretation of the patentability section of the Patent Act of 1952 (35 U.S.C. Section 103). The Courts of Appeal of the Sixth and Second Circuits have handed down diametrically opposite interpretations of this patentability section.

The order of the Court of Appeals of the Sixth Circuit, dated and entered January 6, 1956 (affirming the judgment, findings of fact, conclusions of law, and opinion of the District Court) appears at page 30 of the Appendix to this petition. The judgment appears at page 54; the opinion on page 31; the findings of fact on page 52; and the conclusions of law on page 53 of the Appendix to this Petition.

There was no petition for re-hearing.

There has been no extension of the time for filing this petition.

The jurisdiction of this Court is invoked under the provisions of 28 U.S.C. Section 1254 (1) and Section 2101 (c) and Section 1 (b) of Rule 19 of this Court. These are reproduced in the Appendix to this petition at page 55.

STATEMENT OF QUESTIONS

QUESTION 1.

Does Section 103 of the Patent Act of July 19, 1952, restore the standard of patentability established in *Hotchkiss* v. *Greenwood* (1850), 52 U. S. (11 How.) 248, as held

in the Second Circuit in *Lyon* v. *Bausch & Lomb Optical Company*, 224 F 2d 530, or is that section to be interpreted as embodying the more rigid standard of patentability employed in more recent decisions of this Court rendered prior to the Patent Act of 1952, as exemplified by *The Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corporation*, 350 U. S. 147, and *Cuno Engineering Corp.* v. *Automatic Devices Corporation*, 314 U. S. 84, and followed by the Courts below in the Sixth Circuit in the present case.

QUESTION 2.

Does the decision of the Circuit Court of Appeals for the Sixth Circuit in this case conflict with the decision of the Circuit Court of Appeals for the Second Circuit in the case of *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F 2d 530, 106 USPQ 1 (certiorari denied, 76 S. Ct. 193; 100 L. Ed. 127), in view of the diametrically opposite interpretations of Section 103 of the Patent Act of July 19, 1952 in the two decisions.

QUESTION 3.

Where the courts below have found as a fact that there are differences in structure and in function between the patented invention and the prior art, and where the patented invention overcomes disadvantages of the prior art, solves important problems which even experts had not solved, supplies a long felt want, has been widely recognized for its merit and has enjoyed commercial success, has not the test of patentability of Section 103 been satisfied.

QUESTION 4.

Does the presumption of validity provided for by Section 282 of the Patent Act of July 19, 1952 disappear merely because some prior art relied upon at the trial

was not cited or relied upon by the Patent Office Examiner, or do the Courts below erroneously interpret Section 282 in holding that "There is no presumption of validity over this prior art which the Examiner did not consider".

THE CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Constitutional Provision

Art. 1, Sec. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

The Statutory Provisions

The following provisions from the Patent Act of July 19, 1952 (Public Law 593, 82d Cong. 2d sess., ch. 950; 66 Stat. 792):

The Enacting Clause

AN ACT

To revise and codify the laws relating to patents and the Patent Office, and to enact into law title 35 of the United States Code entitled "Patents".

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That title 35 of the United States Code, entitled "Patents", is revised, codified, and enacted into law, and may be cited, "Title 35, United States Code, section ——", as follows:

* * * *

35 U.S.C. §100. Definitions

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

* * * *

35 U.S.C. §101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. §102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal repre-

sentatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. §103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. §271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for subtantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement.

* * * *

35 U.S.C. §282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

* * * *

The foregoing Code Sections are parts of Section 1 of the Patent Act of July 19, 1952. Sections 4(a), (e) and 5 of the Act are as follows:

Section 4(a)

This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

Section 4(e)

Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.

Section 5

Any rights or liabilites now existing under such sections or parts thereof shall not be affected by this repeal.

STATEMENT OF THE CASE

This patent infringement case involves the validity of a patent to Albert R. DeBurgh, No. 2,317,675 relating to a conveyer system particularly adapted for use in furniture finishng departments of furniture manufacturers.

The conveyer is comprised generally of a trackway which exteds in straight and curved sections through a plurality of "work stations." The furniture being proc-

essed is placed on flat surfaced members called "pallets." The trackway has rollers disposed along its edges and the pallets ride on these. Centrally of the trackway is a guideway slot and each pallet has a downwardly extending stud which is engaged in the guideway. The arrangement keeps the pallets on the conveyer and causes them to be guided as they travel along the trackway (App. 39a).[1]

In accordance with the patent, the pallets may be moved along the trackway either by gravity or by some power means which engages the studs of each pallet to push the pallets forwardly.

Means are provided at each work station so that a pallet may be guided into the work station and there rotated, thus permitting the worker to spray or finish all sides of the furniture carried (App. 40a). At the will of the operator the pallet may be permitted to pass through the work station, and at all times the pallet is being guided and prevented by the guideway from being laterally displaced, or, as expressed in some of the claims, "without disassociation of the pallet from the guideway."

The very essence of the DeBurgh invention is that it is a combination which consists of a guided pallet conveyer on which work supporting pallets associated with a guideway are passed to and through a succession of work stations to which stations the pallets are guided by the guideway, and at such work stations are means for the rotation of such pallets or to permit them to pass through a work station, all while guided and without disassociation of the pallets from the guideway.

While the Courts below held that the patent was invalid, it was *found as a fact* that this improvement was

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[1] Designations such as this are to the appropriate page of Appellant's Appendix in the Court below.

novel and did differ from the prior art both in *"construction and function."* (Findings 2 and 3—Appendix to this petition page 52.)

In 1939 the inventor, Albert R. DeBurgh, operated a small furniture manufacturing plant in Bellingham, Washington (App. 68a) Times were not good, and principally because of high labor costs (App. 75a) serious consideration was given to going out of business. DeBurgh felt that perhaps this problem could be met by introducing equipment which would reduce the amount of indirect labor (App. 76a), and he was authorized by the directors to attempt to accomplish this.

At that time his company, The Bellingham Furniture Manufacturers, Inc., had no conveyers in the finishing department (App. 76a) but employed trucks on wheels to transport the furniture manually from one work area to another. This was regarded by DeBurgh as an inefficient system, and he consulted representatives of several conveyer companies in an attempt to find a conveyer for his finishing department (App. 77a). Among the companies consulted was Mailler-Searles of San Francisco, representing Matthews Conveyor Company, one of the oldest and best known conveyer manufacturers in the country (whose catalogues were relied upon as prior art by defendants below).

DeBurgh was shown by these companies a number of conveyers such as the roller type for loading apple boxes into freight cars; also an overhead type with swinging article holder, such as used for transporting beef through meat packing plants. He found nothing in these to solve his needs (App. 77a) and he then inspected a furniture finishing conveyer used by a company in Portland and which involved the use of wheeled carts. He found this was unsuited to the needs of his company (App. 77a). He learned of a conveyer in Memphis, Tennessee, of the

overhead type with a "A" frame depending from an overhead track and with a platform at the base of the "A" on which rested the articles of furniture being transported. He found that this had disadvantages, the principal one being that dust from sanding and spraying settled on the overheal structure with the surge of the chain which actuated he conveyer thus causing the accumulated dust and drt to settle on the articles being finished. A large perentage of the furniture had to be refinished because of this (App. 78a). Also, the "A" frame being pendulou did not offer a good base for sanding or rubbing operations. Still further, furniture being processed required spraying on all sides, and the supports of the "A" fame would thus come between the workmen and the wor:, and there were other objections as well.

DeBurgh then turned to another conveyer company, the Balsa Company, which offered furniture finishing conveyers to the trade and he engaged its engineer who studied DeBurgh's problem for many days but failed to come up with a suitable answer. This engineer's suggestion was a slat type conveyer, the principal disadvantage of which was that it could not turn a corner (App. 80a).

Finding that the conveyer companies he consulted could not solve the practica problems presented by his effort to maintain quality while minimizing indirect labor, DeBurgh resorted to working out a system of his own—one which would not be subject to these disadvantages but which at the same time would provide a smooth running conveyer on which pallets are guided to and through work stations, at which they could be stopped and rotated or permitted to continue through as desired.

It was not an easy task, but he accomplished it and he had his conveyer fabricated and installed in his factory by the Mailler-Searles Company. It worked well

and effected great savings, (App. 86a) and its merit was recognized immediately by the fabricator, Mailler-Searles, who took a license (App. 89a).

In the 1930's the state of the conveyer art in the field of furniture finishing was rather chaotic. Furniture finishing operations were generally handled manually. The articles were brought into spraying booths, then out into storage areas, then back into another spraying booth, and so forth. A few plants were conveyerized and mostly these were in the South and generally they were of the overhead type (App. 128a), although some "roller conveyers" and some "belt conveyers" were used (App. 133a). Less than ten per cent of the furniture-finishing departments were conveyerized and of that small number, probably eighty or ninety per cent were conveyerized with the overhead type conveyer (App. 135a).

In 1939 George Koch Sons, Inc., were selling various types of conveyers to furniture finishers. Their line included overhead systems, truck systems, gravity "roller" systems, and some belt systems (App. 136a). This was the situation when, in 1947, DeBurgh called upon them (App. 137a) and discussed conveyerization with their chief engineer and other interested personnel (App. 138a). Together they viewed a film showing the DeBurgh conveyer (App. 138a) (this film was shown at the trial of this case and is plaintiff's Exhibit 12). The enthusiastic reaction of those present was that this conveyer provided the answers to problems which had troubled that company for years in their sales and installations of conventional systems which they offered to the furniture industry (App. 138a). George Koch Sons, Inc., became a licensee under the DeBurgh patent.

Following an initial installation at the Grand Rapids Chair Company in Grand Rapids, Michigan (App. 140a), Koch installed some seventy-three systems for sixty-seven different companies over a period of about six

years. These systems were installed in small plants, large plants, high quality furniture plants, and in low quality furniture plants (App. 140a).

An installation was made in North Carolina, and thereafter for a period of about two and one-half years Koch Company sold about one dozen more systems in the South, during which time no other type of conveyer was sold in that area (App. 141a).

Like most of the companies, one of the companies that selected a DeBurgh Conveyer had made a thorough investigation of conveyerized finishing in many Southern, Eastern and Pacific Coast factories, to determine if any system would eliminate excessive handling and still maintain quality. They concluded that the DeBurgh Conveyer was the only one which would meet their exacting requirements and they wrote to DeBurgh (App. 62a) stating that "the DeBurgh Conveyer is the greatest improvement in finishing since the introduction of spray-guns." Other companies indicated their complete satisfaction with the DeBurgh conveyer, which they had chosen after investigating every type and many wrote letters and sent telegrams expressing high praise and recommendation (App. 153a).

From the time they became licensees in 1947 up to the date of the trial, George Koch Sons, Inc., had sales of DeBurgh conveyers aggregating about $2,250,000, and this was on installations which varied in size from $5,000 units all the way up to $100,000 units (App. 145a).

DeBurgh received income from the conveyer business of $197,882 from 1947 to 1952 when he died after this action had been instituted. Up to the time of the trial approximately eighty-five DeBurgh conveyers had been installed (App. 126a).

In the fall of 1947 Kindel Furniture Company of Grand Rapids, Michigan, being faced with the same problem

that had confronted DeBurgh, engaged the services of DeBurgh to prepare a lay-out of a DeBurgh conveyer to suit the particular operations of the Kindel Company. DeBurgh and the Kindel Company entered into an agreement, one condition of which was that if Kindel ordered a DeBurgh conveyer it would place its order with one of the conveyer manufacturers which DeBurgh had already licensed under the patent. The agreement provided for the payment of $500 to DeBurgh upon completion and delivery of the plans, which amount would be credited against the royalty to be paid in the event Kindel Company thereafter placed its order with a DeBurgh licensee.

Pursuant to this agreement DeBurgh completed and delivered the plans and the $500 payment was made. Charles M. Kindel, a Vice President and one of the defendants, expressed his desire to go through with the agreement and have the DeBurgh conveyer installed, and he called George Koch Sons, Inc., and solicited a bid (App. 102a).

However, instead of having George Koch Sons, Inc., install the conveyer, Kindel turned to the defendant, Rapids-Standard Company, who, unknown to DeBurgh, installed the conveyer which was the basis of this infringement suit.

When DeBurgh later learned of this he notified Kindel Company and then brought suit in the District Court for the Western District of Michigan, naming Kindel Furniture Company and Charles M. Kindel as defendants (App. 15a). Upon motion, Rapids-Standard was granted leave to intervene as party defendant, since it had agreed to save Kindel Furniture Company harmless from any claim of infringement of the DeBurgh patent.

DeBurgh subsequently filed an amended complaint alleging that Rapids-Standard Company was manufactur-

ing and selling to others than the Kindel Company (App. 31a). Upon defendant's motion for a separate trial of the issues of validity of the patent and infringement as to the conveyer system installed in the Kindel Company, the lower Court ruled that the only issues which would be considered and determined would be the issues of validity of the patent and of infringement as to the conveyer system manufactured by Rapids-Standard Company and installed in the Kindel Company.

Prior to the trial both parties took depositions and both were examined before the trial by opposing counsel.

The defendants relied on an assortment of prior art patents, some of which related to a "lazy susan" (App. 273a), a roller coaster (App. 287a), and a San Francisco cable car arrangement (App. 262a). The principal prior patent relied upon was issued in 1888 on a lazy susan for passing food around a dining table (App. 273a). It had been cited also by the Patent Office during the prosecution of the DeBurgh patent application.

Defendants also relied upon an alleged prior use of a conveyer in a stove company in Lorrain, Ohio (App. 245a), a conveyer which the lower Court held differed in structure and in function from the conveyer claimed by DeBurgh (App. 56a): a conveyer which was used for a few years, which "nobody liked" (App. 119a) and which was then dismantled and scrapped (App. 114a-121a).

The lower Court in its opinion held all twelve claims of the DeBurgh patent to be invalid (App. 59a). It found as a fact (App. 59a and appendix to this petition p. 52) that there were *differences in structure and in function* over the prior art, but it held that these differences did not result in imparting to the DeBurgh structure that quality which would make it an "invention" (App. 58a).

The Court of Appeals for the Sixth Circuit, upon appeal, rendered no formal opinion but merely issued an order in accordance with which it adopted as its own the opinion, findings of fact, conclusions at law, and judgment of the lower Court (Appendix to this petition p. 30).

From the opinion of the lower Court it is evident that that Court judged patentability by the very rigid standard employed by the Supreme Court in recent years, prior to the enactment of the Patent Act of 1952. In fact, the lower Court quoted profusely from the A & P case (App. 45a)[1] and specifically referred to the fact that it recognized "that decisions in recent cases indicate a clear trend toward a higher standard of invention."

JURISDICTION OF THE COURT OF FIRST INSTANCE

This was a civil action under the Acts of Congress relating to patents, and the jurisdiction of the Court of first instance is based upon 28 U.S.C. 1338(a) (June 25, 1948, ch. 646, sec. 1, 62 Stat. 931) and 1400(b), and 35 U.S.C. 67 (1946 ed.) (R.S. 4919, 4921).

ARGUMENT

Argument on Questions 1 and 2

QUESTION 1.

Does Section 103 of the Patent Act of July 19, 1952, restore the standard of patentability established in *Hotchkiss* v. *Greenwood* (1850), 52 US (11 How.) 248, as held in the Second Circuit in *Lyon* v. *Bausch & Lomb Optical*

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[1] *Great Atlantic and Pacific Tea Company* v. *Supermarket Equipment Corporation*, 350 U. S. 147.

Company, 224 F. 2d 530, 106 USPQ 1, or is that section to be interpreted as embodying the more rigid standard of patentability employed in more recent decisions of this Court rendered prior to the Patent Act of 1952, as exemplified by *The Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corporation*, 350 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127, 87 USPQ 303, and *Cuno Engineering Corp.* v. *Automatic Devices Corporation*, 314 U. S. 84, 62 S. Ct. 476, 86 L. Ed. 474, and followed by the Courts below in the Sixth Circuit in the present case.

QUESTION 2.

Does the decision of the Circuit Court of Appeals for the Sixth Circuit in this case conflict with the decision of the Circuit Court of Appeals for the Second Circuit in the case of *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 106 USPQ 1 (certiorari denied, 76 S. Ct. 193, 100 L. Ed. 127), in view of the diametrically opposite interpretations of Section 103 of the Patent Act of July 19, 1952, in the two decisions.

In the present case the lower Courts followed the rigid standard of invention. The opinion of the lower Court stated:

> "The court recognizes that decisions in recent cases indicate a clear trend toward a higher standard of invention." [1]

And the Court also held that the new Patent Act

> "did not change the tests for determining patentability." [2]

The opinion of the lower Court quoted at some length from *Great Atlantic & Pacific Tea Company* v. *Supermar-*

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[1] *DeBurgh* v. *Kindel*, 125 F. Supp. 468, at 473.

[2] 125 F. Supp. at 474.

ket Equipment Corp., 350 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127, 87 USPQ 303, which in turn referred to *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58.

The opinion further referred to a previous decision of the Sixth Circuit in *General Motors Corp.* v. *Estate Stove Co.*, 203 F. 2d 912, (certiorari denied by this Court 346 US 822, 98 L. Ed. 348, 74 S. Ct. 37) holding that the new Patent Act, including Section 103 (35 U.S.C. Section 103), merely codified the law.

Such holdings as in the Courts below in the present case and in *General Motors Corp.* v. *Estate Stove Co. (supra)* in the Sixth Circuit are in direct conflict with the decision in *Lyon* v. *Bausch & Lomb, (supra)* in the Second Circuit, where Judge Learned Hand clearly held that Section 103 of the Patent Act of 1952 did in fact restore the test of patentability of *Hotchkiss* v. *Greenwood* "substantially *in ipsissimis verbis.*"[1]

Judge Hand reviewed the history of the problem and concluded that the Congress in passing the Patent Act of 1952 clearly intended to restore that early standard and instruct the courts not to be as rigid with respect to patentability as the Supreme Court has been in recent years.

Following the constitutional provision that Congress has the power "To promote the Progress of Science and

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[1] At least one other Circuit has interpreted §103 as a substantial change. The United States Court of Appeals for the District of Columbia in *L-O-F Glass Fibers Co.* v. *Watson*, 107 USPQ 202 said:

> "We may safely assume that the Patent Act of 1952, 35 U.S.C.A. §103, was intended to restore 'the law to what it was when the court announced the definition of invention.' See discussion by Judge Learned Hand in Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530, 535-36, 106 USPQ 1, 6-7 (2d Cir. 1955)."

useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries" (U. S. Constitution Article I, Section 8, Clause 8), Congress passed the first Patent Act in 1790, and in 1793 followed with a second Patent Act which set forth requirements by which proper subject matter was to be tested to determine whether a patent should be granted. It was this Act which provided that a person who invented or discovered a "new and useful" art, machine, manufacture or composition of matter, or improvement thereon, could obtain a patent therefor.

From that date up to the enactment of the Patent Act of 1952 there was no other statutory test or requirement.

However, in 1850 the Supreme Court in *Hotchkiss* v. *Greenwood*, 52 U. S. (11 How.) 248, ruled that it was not enough that the subject matter be "new" in the sense theretofore provided. The Court found that

> "unless more ingenuity and skill in applying the old method of applying the shank in the knob were required in the application of it to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilled mechanic, not that of the inventor."

This requirement for patentability established the standard for patentability which remained such until about twenty-five or thirty years ago. Though "the Court never formally abjured it; nor has it ever substituted any other definite test" (*Lyon* v. *Bausch & Lomb Optical Company*, *supra*) the Supreme Court did about that time begin to make it evident by its decisions that it had adopted a much higher standard of patentability. So pronounced was this high and rigid standard that it became a very rare instance when the Supreme Court held a patent to be valid.

Examples of cases in which the rigid standard of patentability was applied by this Court are *Cuno Engineering Corp.* v. *Automatic Devices Corporation* (*supra*), *Jungersen* v. *Ostby and Barton Co.*, 335 U. S. 560 (1949), 93 L. Ed. 235, 69 S. Ct. 269, 80 USPQ 32, and in *The Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corporation* (*supra*). The standard was placed so high by the Supreme Court that Mr. Justice Jackson was compelled to observe, in his dissenting opinion in the Jungersen case, that "the only patent that is valid is one which this Court has not been able to get its hands on."

It was under these conditions that Congress passed the Patent Act of 1952.

There has been no more baffling problem in the law than that of patentability. The interpretation of a statute which sets forth the requirements for patentability is a federal question of great import. With Courts of different Circuits in direct conflict on the question it is important, we submit, that the Supreme Court consider and determine whether Section 103 does, in fact, restore the test of patentability to that first laid down by the Court in *Hotchkiss* v. *Greenwood* (*supra*).

We feel that the Court, after a careful consideration of the facts, including the legislative history of the Act (much of which has been passed over by those lower Courts which have considered the question), will conclude that Congress did, in fact, intend to restore to the patent law the test of patentability enunciated first in *Hotchkiss* v. *Greenwood* (*supra*).

We submit the following ten considerations in support of that view:

1. The title to the Act itself indicates that it was not intended merely as a codification. The Act is entitled "An Act to *Revise* and Codify the Laws Relating to Pat-

ents and the Patent Office, and to Enact into Law Title 35 of the United States Code entitled 'Patents.'" [Emphasis added] (66 Stat. 792) (1952).

2. Section 103 is new in statutory patent law. There never has been a similar or analogous provision to codify. Its mere presence in the Act indicates the Act is not merely a codification. Other sections also were new to the stautory law for the first time, such as Sections 271 and 282.

3. The legislative history shows a dissatisfaction by Congress with the position of the Supreme Court with respect to the standard of invention, indicating that Congress did not desire to continue the standard of invention the Court had adopted in recent years. (See Hearings before Subcommittee No. 3 of the House Committee on the Judiciary on H. R. 3760, 82nd Cong., 1st Sess. Sec. 9 at 134-135.)

4. The legislative history reveals that the Congress had in mind the test of *Hotchkiss* v. *Greenwood* (*supra*), since they definitely referred to 1850. The "Revision Note"[1] in part says:

> "There is no provision corresponding to the first sentence [of Sec. 103] explicitly stated in the patent statutes, but the refusal of patents by the Patent Office and the holding of patents invalid by the Courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850."

And again:

> "Section 103, for the first time, provides a condition which exists in the law and has existed for more

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[1] Revision Note included as appendices in both House and Senate Reports to accompany H. R. 7794 (H.R. Rep. No. 1923, 82nd Cong. 2d Sess. 18 [1952]; S. Rep. No. 1979, 82nd Cong. 2d Sess. 18 [1952])

than one hundred years, but only by reason of decisions of the Courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent."

5. The "Revision Note" states that "this paragraph (Sec. 103) is added with the view that an explicit statement in the statute may have some stabilizing effect."

6. And again the "Revision Note" refers to the fact that "this Section should have a *stabilizing* effect and *minimize great departures which have appeared in some cases.*" (Emphasis added.) When the "Revision Note" speaks of "minimizing great departures which have appeared in some cases" it indicates Congress disapproved of such departures from the patentability test as first laid down in *Hotchkiss* v. *Greenwood* (*supra*). This phrase in the "Revision Note" thus signifies that a substantive change was intended.

7. The Congress in its reports on the measure speak of "changes in *substantive* statutory law" and also of "*major* changes or innovations." Thus, the "Revision Note" indicates that Section 103 was clearly not a codification when it says:

> "Although the principal purpose of the bill is the codification of Title 35, United States Code, and involves simplification and clarification of language and arrangement and elimination of obsolete and redundant provisions, *there are a number of changes in substantive statutory law.* These will be explained in some detail in the revision notes keyed to each section which appeared in the appendix to this report. *The major changes or innovations in the title consist of incorporating a requirement for invention in* §103 and the judicial doctrine of contributory infringement in § 271." [Emphasis added]

Thus, we have here a clear reference to a change in *substantive statutory law* and it is referred to as a

"*major*" change. It is submitted that if the Congress did not expect the statutory expression to instruct the courts as to the standard which should be applied, it would hardly have denominated the provision as constituting a "*major*" change.

8. The language used in Section 103 indicates an intent on the part of Congress to moderate "the extreme degree of strictness exhibited by a number of judicial opinions over the past dozen or more years," and to express at least a hope for some change to an attitude more favorable to patents.

It is submitted that great weight should be accorded to the language actually used in the section since "a variety of expressions used in decisions were available, including some stated with an extreme degree of strictness, which could have been used as the model for the phraseology to be adopted, but the language selected was of the most moderate variety."[1]

9. The second sentence of Section 103 clearly indicates an intent on the part of Congress to "eliminate the rigid subjective 'flash of genius' requirement" (*R. M. Palmer Co.* v. *Luden's Inc.*, 128 F. Supp. 672, 675). This indicates the attitude of Congress in passing the new Patent Act and it is submitted that it has a bearing on the interpretation of the Act. It is submitted that it indicates a disposition on the part of the Congress to look more favorably upon patents and should be read in connection with the first sentence of Section 103 in ascertaining the meaning of the entire section. (See Federico Commentary on the New Patent Act, 35 U.S.C.A., Comm. at 23).

10. The inclusion of Section 4(a) in the Act indicates an intent that §103 changes the law.

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[1] Federico Commentary on the New Patent Act, 35 U.S.C.A., Comm. at 22.

Section 4(a) states that the Act is to apply retroactively to patents previously granted. Unless there had been a clear intent to change the law there would have been no need to include Section 4(a). In other words, if the statute did not change the law it would make no difference whether the statute was retroactive or not.[1]

We submit that in all the patent law there can be no more important federal question which should be decided by this Court. With some circuits following one test and others another, only confusion, uncertainty and chaos can result until this Court speaks.[2]

Argument on Question 3

QUESTION 3.

Where the courts below have found as a fact that there are differences in structure and in function between the patented invention and the prior art, and where the patented invention overcomes disadvantages of the prior art, solves important problems which even experts had not solved, supplies a long felt want, has been widely recognized for its merit and has enjoyed commercial success, has not the test of patentability of Section 103 been satisfied.

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[1] This was the reasoning of Judge Hand in *Lyon* v. *Bausch & Lomb Optical Co. (supra)*.

[2] Since his opinion in the *Lyon* v. *Bausch & Lomb* case *(supra)* Judge Hand testified before the Senate Subcommittee on Patents, Trademarks and Copyrights. With respect to the effect of this Court's decisions on the Courts below (prior to the Patent Act of 1952) he remarked, "We understood we were to be very strict, very severe." Moreover, he referred to the fact that his Court had construed the Act "as meaning that the old rules were to apply" and expressed the hope that this Court would resolve the question. (Hearings before the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate, 84th Congress, 1st Sess. pursuant to S. Res. 92. on October 10, 11 and 12, 1955, page 120.)

The Courts below held that the patentee's conveyer was novel. There was no prior patent, no prior publication, no prior use which disclosed the invention. The Court, in holding that the patented device did not meet the standards of patentability, relied upon a large number of prior patents and an alleged prior use which disclosed certain elements of the DeBurgh conveyer (App. 56a). The Court held that nothing more than the skill of a mechanic was involved in constructing the patented conveyer in view of the prior art disclosures (App. 59a). As brought out hereinbefore, in reaching this conclusion the Court relied upon a more rigid standard of invention than is applicabe under the Patent Act of 1952. The invention would not be considered obvious under the correct test of patentability.

The Court below found as a fact that the patentee's conveyer differed both structurally and functionally from the prior art and prior use cited by the defendant (App. 58a). There was no prior patent nor prior use which disclosed the structure of the DeBurgh conveyer and there was no prior patent nor prior use which performed the same functions as the DeBurgh conveyer. The testimony in the case clearly showed that the patented invention overcame problems which the prior art could not solve (App. 77a-89a). The testimony of the patentee showed that prior to making the instant invention he consulted recognized experts in the field of conveyers to resolve the problems he was faced with in his furniture factory. These experts in the field could not offer an acceptable solution (App. 77a-80a). The invention met a real need in the art (App. 138a, 140a, 141a, 153a) and was met with great commercial success (App. 126a, 145a).

It has long been a criterion of unobviousness that where there has been a need for an invention, or problems which have troubled an art, and that need has not

been fulfilled, or the problems have not been solved until the patentee came along, the patented invention would be unobvious to one skilled in the art and would be patentable. This is particularly true where the invention, once disclosed, has met with success and has been accepted and praised. (*Patent Royalties Corporation et al* v. *Land-o'-Lakes Creameries et al*, 89 F. 2d, 624, 33 USPQ 402).

Thus, in deciding whether a new combination is inventive, the need, the presence of problems, the search for the answers to these problems and their eventual solution, the acceptance and commercial success of the invention are all important in showing that an invention is not obvious and is patentable. (*Goodyear Co.* v. *Ray-O-Vac Co.*, 321 U.S. 275).

The present invention solves a problem which the prior art could not solve, is both functionally and structurally different from the prior art disclosures, and has been widely accepted and has met with great commercial success. These are the criteria with which inventions have long been gauged. These are the criteria which the courts have used in applying the test of the *Hotchkiss* v. *Greenwood* decision and, it is submitted, these are the criteria which should have been applied in the present case. It would seem clear that the invention meets the test of invention of Section 103 of the Patent Act. The invention could not be said to be obvious to a person skilled in the art under the foregoing circumstances.

Argument on Question 4

QUESTION 4.

Does the presumption of validity provided for by Section 282 of the Patent Act of July 19, 1952, disappear merely because some prior art relied upon at the trial was not cited or relied upon by the Patent Office Exam-

iner, or do the Courts below erroneously interpret Section 282 in holding that "There is no presumption of validity over this prior art which the Examiner did not consider."

The statute section here involved, states that

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it" (35 U.S.C. § 282).

This provision incorporates into the statute law a presumption which the courts have recognized almost from the beginning of our patent system. It has been made a positive requirement of the statute law in view of the fact that some courts in recent years have either disregarded this principle or have but paid it lip service.

The Courts below in the present case, while referring to the presumption, attempt to introduce a qualification which never has been a part of the law, and which, if approved, would have the effect of proliferating the will of the Congress.

That qualification is stated in the opinion (Appendix to this petition at page 38) thusly

> "There is no presumption of validity over this prior art which the Examiner did not consider."

There is no basis for such a holding and it finds no proper place in the patent law. The mere presence of prior art other than that cited by the Patent Office Examiner does not cause the presumption of validity to disappear. There is still the heavy burden on the party attempting to establish invalidity to prove that the prior art upon which he relies does in fact clearly and convincingly invalidate the patent.

This contention is believed to be so clear as to require no supporting citations. None could be found which would support the lower Courts' statement.

CONCLUSION

It is submitted that there is a direct conflict in the interpretation of Section 103 of the Patent Act in this decision of the Sixth Circuit and the decision of the Second Circuit in the *Lyon* v. *Bausch and Lomb Optical Co.* case. This divergence of interpretation is substantial and has led to "embarrassingly different" results. This divergence of interpretation has created widespread confusion and has resulted in a general inability to evaluate patent rights properly.

It is further submitted that the courts below have applied the incorrect test of patentability and that the application of this incorrect test and a misinterpretation of Section 282 of the Patent Act have resulted in the court's erroneous finding that all of the claims of the petitioner's patent are invalid.

Certiorari should be granted in this case in order to settle this most significant federal question as to the interpretation of Section 103 of the Patent Act and to restore to petitioner the patent rights to which he is justly entitled.

Respectfully submitted,

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Attorney for Petitioner

April 2, 1956

APPENDIX

No. 12387

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

MARIA LUISA DEBURGH, EXECUTRIX, ESTATE OF ALBERT R. DEBURGH, PLAINTIFF-APPELLANT

v.

KINDEL FURNITURE COMPANY, CHARLES M. KINDEL, and RAPIDS-STANDARD COMPANY, INC., DEFENDANT-APPELLEE

ORDER

Before SIMONS, Chief Judge; ALLEN and MCALLISTER, Circuit Judges.

The above cause coming on to be heard upon the transcript of record, the briefs of the parties, and the arguments of counsel in open court, and the court being duly advised,

Now, therefore, it is ordered, adjudged, and decreed that the judgment of the district court be and is hereby affirmed in accordance with the findings of fact, conclusions of law, and for the reasons stated in the opinion of Judge Starr.

Approved for entry:

.....
United States Circuit Judge

OPINION

Albert R. DeBurgh as the patentee and owner of United States Letters Patent No. 2,317,675 issued April 27, 1943, for a "conveyer system" filed complaint alleging infringement of said patent by defendants Kindel Furniture Company and Charles M. Kindel. DeBurgh asked for an injunction against further infringement, an accounting of profits, treble damages, costs, and attorney fees. On its motion, the Rapids-Standard Company, Inc., a Michigan corporation, was granted leave to intervene as a party defendant and file answer.[1] The defendants Kindel Company and Charles M. Kindel, and defendant Rapids-Standard, in their respective answers denied infringement and alleged that the DeBurgh patent was invalid because of prior art anticipation and lack of invention. In their supplemental answer the defendants asked for a declaratory judgment determining that the DeBurgh patent was invalid, and that the accused conveyer structure manufactured by defendant Rapids-Standard and used by the Kindel Company did not infringe.[2] The defendants' allegation of invalidity of patent and their request for a declaratory judgment of in-

[1] Rapids-Standard Company had agreed to save the Kindel Furniture Company harmless from any claim for infringement of the DeBurgh patent.

[2] DeBurgh subsequently filed an amended complaint alleging that defendant Rapids-Standard Company was manufacturing and selling to others than the Kindel Company conveyor systems which infringed his patent. The defendants' motion for a separate trial of the issues of validity of patent and infringements as to the conveyer system installed in the Kindel factory, raised by DeBurgh's original complaint and the defendants' answers, was granted. Therefore, any issues relative to conveyer systems manufactured and sold by Rapids-Standard to others than the Kindel Company are not involved and are not considered in this opinion. That is to say, the only issues considered and determined in this opinion are the issues of validity of patent and of infringement as to the conveyor system manufactured by Rapids-Standard Company and installed by the Kindel Company in its factory.

validity, put in issue the question of the validity of all claims of the patent in suit. Kawneer Co. v. Pittsburgh Plate Glass Co., D. C., 109 F. Supp. 228. Albert R. DeBurgh died December 24, 1952, and in pursuance of stipulation it was ordered that Maria Luisa DeBurgh, executrix of his estate, be substituted in his place as plaintiff.

In support of their claim of invalidity of patent because of prior art anticipation and lack of invention, the defendants cite the following patents: Fitzhenry 76,619 issued April 14, 1868; Eppelsheimer 166,975 issued Aug. 24, 1875; Aiken 393,051 issued Nov. 20, 1888; Hogg 519,630 issued May 8, 1894; Baker 907,116 issued Dec. 22, 1908; Rebstock 1,505,971 issued Aug. 26, 1924; Knight 1,540,021 issued June 2, 1925; Olson 1,732,376 issued Oct. 22, 1929; Howe 1,733,409 issued Oct. 29, 1929; Francis 1,792,533 issued Feb. 17, 1931; Baker 1,831,283 issued Nov. 10, 1931; Dahms 1,889,274 issued Nov. 29, 1932; Hormel 1,914,806 issued June 20, 1933; Kimball et al. 2,090,129 issued Aug. 17, 1937; and Landahl 2,187,498 issued Jan. 16, 1940. The file wrapper indicates that of the above, only the Hogg, Rebstock, Knight, Francis, Baker, Dahms, Kimball et al., and Landahl patents were cited as references by the examiner. In their second supplemental answer and their answers to plaintiff's interrogatories and in their notice of prior art, the defendants also cite in support of their claim of invalidity: Klinik et al. 382,043 issued May 1, 1888; Taylor et al. 815,986 issued Mar. 27, 1906; Hutton 1,448,119 issued Mar. 13, 1923; Stutsman 1,534,334 issued April 21, 1925; Prince 1,716,664 issued June 11, 1929; Anderson 1,825,038 issued Sept. 29, 1931; and Taylor 1,835,823 issued Dec. 8, 1931. The defendants also alleged that the DeBurgh patent is invalid, because prior to the alleged invention and for more than two years prior to the filing of the application, all material and substantial parts and

elements of the patent had been in public use and had been described in printed publications. Further, the defendants alleged that about 1928 or 1929 the Logan Company of Louisville, Kentucky, had designed and constructed a conveyer system which included the elements of the structure described and claimed in the patent in suit, and that the Logan conveyer was installed and thereafter operated in the plant of the Direct Action Stove division of the American Stove Company (now Magic Chef, Incorporated) at Lorain, Ohio.

As stated in the specifications, the patent in suit relates to a claimed improvement in the method of utilizing conveyers for the more expeditious and economical manufacture and finishing of furniture and other articles requiring a succession of operations, such as, for example, the sanding, staining, wiping, drying, sealing, decorating, lacquering, and varnishing of pieces of furniture. Claims 1, 3, 4, and 5, on which plaintiff bases her claim of infringement, and claim 11, which are reasonably illustrative of all claims, provide as follows:

> "1. In combination, a conveyer means including a guideway leading through a succession of work stations, a work mounting pallet associated with the conveyer for guided travel therealong by the guideway through the work stations and means located at the work stations onto which the pallet will be directed by the guideway for a continuation of travel and for rotation while at the work stations without disassociation of the pallet from the guideway."

> "3. In a system for (of) the character described, a conveyer means leading through a succession of work stations, work mounting pallets associated with the conveyer for travel in succession therealong, each independently of the others for variation in spacing and intermittent travel, and means located at the work stations onto which the pallets will be directed by the guideway and supported for continuation of travel and for rotation at the work stations."

"4. In a system of the character described, a conveyer means leading through a succession of work stations, a power driven belt operable along the conveyer means, work mounting pallets associated with the conveyer means for travel therealong, cooperating means on the belt and on the pallets for the advancement of the pallets, and supports at the work stations onto which the pallets will be directed for conveyance through the stations and on which they may be rotated without disassociation from the conveyer means."

"5. In a system of the character described, a continuous guideway leading through a succession of work stations, a continuously moving belt operable along the guideway, conveyer rollers mounted along the guideway between the stations, work mounting pallets associated with the guideway for support and travel on said rollers and for guidance by the guideway in travel, cooperating means on the belt and on the pallets for the advancement of the pallets along the guideway and permitting variation in their spacing within predetermined limits, and supports at the work stations onto which the pallets will be directed for their continuation of travel through the station and for rotation."

"11. In a system of the character described, a main trackway leading through a succession of work stations, and a plurality of receiving trackways, each with an end terminating adjacent the main trackway, a belt guideway extending along the main trackway, and having a longitudinal slot, a conveyer belt mounted for travel in the guideway and having abutments at spaced intervals therealong, a plurality of work mounting pallets mounted for travel on the trackways, a pivot and guide stud fixed to each pallet and extended downwardly therefrom into the guideway slot for engagement by a belt abutment for pushing the pallet along the trackway and for retaining the pallet against lateral displacement from the trackway, a caster bed located between the main trackway and the adjacent ends of the receiving trackways across which pallets may be transferred from the main trackway to any of the receiving

trackways, and slotted guideways extending along the receiving trackways for reception of the pallet studs to retain the pallets against lateral displacement from these trackways while advanced therealong."

The patent in suit shows a combination of elements consisting of a trackway with mounted conveyer rollers, having a central guideway formed by two parallel spaced angle irons, within which travels a *power driven chain belt* extending throughout the full length of the conveyer. Attached to this moving belt are upright, spaced-apart lugs. Supported and traveling on the trackway are removably mounted work pallets or platforms upon which pieces of furniture or other articles are placed for transportation. These pallets or platforms are independent of each other and each has a central, fixed pin or stud extending down into the guideway to be engaged by the lugs on the power-driven belt, whereby the belt moves the pallets along the trackway without lateral displacement. The spacing between the lugs is considerably greater than the over-all length of each of the pallets. Located at different places along the conveyer are so-called work stations, and at each of these stations swivel casters replace the rollers on the trackway to facilitate the rotation of the pallets without their removal from the conveyer, and without their being lowered or raised from the level of the conveyer. These swivel casters support the pallets both for rotation and for travel through the work station, and means is provided for the transfer of the pallets from the main trackway to receiving trackways.

The accused conveyer structure manufactured by defendant Rapids-Standard Company and installed by defendant Kindel Company in its factory, consists primarily of a gravity conveyer system as distinguished from the powered conveyer system described in the claims of the DeBurgh patent and as shown in the drawings illus-

trating that patent.[3] The defendants' conveyer structure comprises a track consisting of a pair of side rails upon which are mounted freely rotatable skate wheels. Removably mounted work pallets or platforms, upon which articles of furniture are placed for transportation, rest upon the skate wheels. The conveyer track, except at points where it is raised to give gravity movement to the pallets, is inclined downwardly in the direction of the movement of the pallets through the conveyer system. In the center of the track, midway between the skate wheels, are located two spaced-apart angle irons which form a guideway. The pallets or platforms are independent of each other, and on the bottom of each pallet is a horizontally positioned skate wheel, rotatable about a vertical axis, and this skate wheel is seated in the guideway. The angle irons forming the guideway for the skate wheel prevent lateral or sideways displacement of the pallet. At various points within the gravity-operated portions of the conveyer are located so-called work stations, where all sides of the piece of furniture being carried on the pallet can be brought before the workman without removal of the pallet from the conveyer. No powered means is provided to move the pallets into, through, and out of the work stations. The defendants' conveyer system is of considerable length, and in order to give the track sufficient downward slope to give gravity movement to the pallets, short sections of the track at several points on the conveyer line are elevated by means of upward sloping powered ramps or sections, each ramp being independently operated. While moving up and over the powered ramps which elevate the track, the pallets rest upon spaced-apart chains, and move merely through their bottom surfaces bearing on

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[3] Plaintiff's witness Tridwell testified:

"Q. In other words, in those (DeBurgh) conveyers you do not use gravity in any portion of the conveyer, storage or main line?

"A. That is correct, we do not use gravity to propel the pallets."

the chains, there being no lugs, pins or abutments on the chains to engage the pallets. Throughout the entire conveyer system there is no mechanism in the guideway to engage the wheel on the bottom of the pallet to push or move it forward. Some of the work stations consist of a section of the track rotatably mounted on a pneumatic lift, whereby the pallet at the work station may be raised above the level of the track and rotated. At other work stations on the conveyer, swivel casters are substituted for the skate wheels to facilitate rotation of the pallets. Other work stations employ raised wheels on each side of the conveyer track upon which the pallets may be rotated and over which they must pass as they travel through the station. In some of the work stations the guideway ends short of the station and in others the guideway passes through the station. In instances where the guideway at the work station has been removed, planks are placed in the trackway to permit the worker to stand on the conveyer or walk over it, and where a pair of planks are so used, they are spaced apart, creating a slot between them to permit the passage of the skate wheel on the bottom of the pallet, the slot functioning as a pallet guide. The pallets or platforms on the defendants' conveyer are entirely independent of each other and the spacing between them is not fixed or limited, as there is no moving chain, lugs or mechanism in the guideway to limit the spacing. Means is provided at the work stations to check the forward movement of the pallet and hold it in a fixed location during rotation, and for releasing the pallet so that it may be moved forward when work at the station is completed.

The questions presented for determination by the court are: (1) Is the DeBurgh patent No. 2,317,675 valid, and (2) if valid, are claims 1, 3, 4, and 5 infringed? In considering the question of the validity of the patent here in suit, the court recognizes that decisions in recent cases indicate a clear trend toward a higher standard of inven-

tion. See *Kawneer Co.* v. *Pittsburgh Plate Glass Co.*, D. C., 109 F. Supp. 228, 232, and authorities cited. The plaintiff's patent is presumed to be valid. 35 U. S. C. § 282. However, this presumption of validity is rebuttable, and it may be noted that the defendant cites certain prior art patents and prior public use of the Logan conveyer system, which were not cited and apparently not considered by the examiner. There is no presumption of validity over this prior art which the examiner did not consider. *O'Leary* v. *Liggett Drug Co.*, 6 Cir., 150 F. 2d 656, certiorari denied 326 U. S. 773. Futhermore, the fact that the examiner did not mention certain prior art does not raise a presumption that he was aware of it and did not consider it applicable. *Himmel Bros. Co.* v. *Serrick Corporation*, 7 Cir., 122 F. 2d 740, 745; *H. Schindler & Co., Inc.* v. *C. Saladino & Sons, Inc.*, 1 Cir., 81 F. 2d 649, 651; *Robinson Aviation, Inc.*, v. *Barry Corp., D. C.*, 106 F. Supp. 514, 519. The scope of the patent in suit is limited to the invention described in the claims when read in the light of the specifications and drawings, but the claims limit the boundaries of the patent and may not be enlarged by the specifications. In other words, the specifications may explain, but may not expand or enlarge, the patent claims. *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211; *Motion Picture Patents Co.* v. *Universal Film Mfg. Co.*, 243 U. S. 502; *Hutzler Bros. Co.* v. *Sales Affiliates, Inc.*, 4 Cir., 164 F. 2d 260. Furthermore, DeBurgh, the patentee, is presumed to have known and is chargeable with knowledge of everything disclosed by the prior art in the field of conveyer systems and of all devices in that field which have been in prior public use. *Zephyr American Corporation* v. *Bates Mfg. Co.*, 3 Cir., 128 F. 2d 380; *Cutler Mail Chute Co.* v. *Capitol Mail Chute Corporation*, 2 Cir., 118 F. 2d 63; *Detroit Stoker Co.* v. *Brownell Co.*, 6 Cir., 89 F. 2d 422, 424.

The law has long been established and is restated in the new Patent Act of 1952, 35 U. S. C. § 282, that the burden is upon the defendants to establish their claim of invalidity. Furthermore, that burden must be sustained by clear, satisfactory, and convincing evidence. *Crosley Corporation* v. *Westinghouse Electric & Mfg. Co.*, 3 Cir., 152 F. 2d 895; 2 *Walker on Patents*, Deller's Ed., § 276, pp. 1272, 1273. However, it has been held that the new Patent Act, 35 U. S. C. § 1 et seq., did not change the tests for determining patentability, and it still remains for the court to determine whether, within the meaning of the statute conferring patent monopoly, there is invention and, therefore, patentability. *General Motors Corp* v. *Estate Stove Co.*, 6 Cir., 203 F. 2d 912, 915 (opinion on rehearing). In the case of application of *O'Keefe*, 40 C. C. P. A., Patents, 202 F. 2d 767, 771, the court said: "The Patent Act of 1952, . . . which took effect January 1, 1953, has apparently neither raised nor lowered the standard of invention." In *Interstate Rubber Products Corp* v. *Radiator Specialty Co.*, 4 Cir., 214 F. 2d 546, 549, the court said:

> "As stated in the Senate and House Reports during the enactment of the statute by Congress and in recent decisions of the courts, the provisions of § 103 (35 U. S. C. § 103) merely codified the law laid down by the courts during the past hundred years, and were added to the statute for purposes of uniformity and definiteness. See *Stanley Works* v. *Rockwell Mfg. Co.*, 3 Cir., 203 F. 2d 846; *General Motors Corp.* v. *Estate Stove Co.*, 6 Cir., 203 F. 2d 912."

The plaintiff's patent in suit is a combination improvement patent comprising an accumulation or aggregation of old parts or elements with some slight changes, modifications or substitutions. To constitute patentable invention an aggregation of old elements or parts must cooperate to produce a new, unobvious, and unexpected result. Application of Bowen, 39 C. C. P. A., Patents, 197 F. 2d 553. If invention is absent, mere utility and

novelty are not alone sufficient to sustain the validity of a combination patent. In *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 150, 152, the Supreme Court said:

> "It is agreed that the key to patentability of a mechanical device that brings old factors into cooperation is presence or lack of invention. . . .
>
> "The negative rule accrued from many litigations was condensed about as precisely as the subject permits in *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 549 (58 S. Ct. 662, 664, 82 L. Ed. 1008): 'The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.' To the same end is *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U. S. 350 (59 S. Ct. 897, 83 L. Ed. 1334), and *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (62 S. Ct. 37, 86 L. Ed. 58). The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. . . .
>
> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly."

See also *Sinclair & Carroll Co., Inc.*, v. *Interchemical Corporation*, 325 U. S. 327, 330, 65 S. Ct. 1143, 89 L. Ed.

1644; *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U. S. 320, 65 S. Ct. 647, 89 L. Ed. 973; *General Motors Corp.* v. *Estate Stove Co.*, 6 Cir., 201 F. 2d 645, rehearing denied 203 F. 2d 912.

The test of patentability was recently well expressed in *Buffalo-Springfield Roller Co.* v. *Galion Iron Works Mfg. Co.*, 6 Cir., (decided Sept. 29, 1954, 103 USPQ 72) — F. 2d—:

> "The patent law requires not only that the subject-matter of a patent must possess novelty and utility but must also demonstrate an exercise of the inventive faculty. *Seymour* v. *Ford Motor Company*, 6 Cir., 44 F. 2d 306. The Court of Appeals of the Ninth Circuit has recently in *Kwikset Locks, Inc.*, v. *Hillgren*, 9 Cir., 210 F. 2d 483, put it this way: 'Moreover, a truly inventive combination must create what had not before existed or bring to light what lay hidden from vision in a way which can be distinguished from "simple mechanical skill." A mere advance in efficiency and utility is not enough to convert a noninventive aggregation into a patentable combination.'"

In *Interstate Rubber Products Corp.* v. *Radiator Specialty Co.*, 4 Cir., 214 F. 2d 546, 548, the court said:

> "It is quite impossible to define patentability except in the most general terms. It cannot be denied merely on the ground of the simplicity of a discovery, as appears in the classic example of the Eibel patent, *Eibel Process Co.* v. *Minnesota Ontario Paper Co.*, 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523; see also *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac*, 321 U. S. 275, 64 S. Ct. 593, 88 L. Ed. 721; but it does not come into being merely because the device is novel and represents an interesting and useful improvement. The touchstone is whether the new thing is beyond the ability of the worker of ordinary skill in the field, and neither the courts nor Congress have been able to offer a more definite test, so that in the end it must be left to the judgment of the courts in controverted cases to apply the formula to the specific facts; and

> the judges may not endow with the quality of invention every new and useful advance amidst the myriad activities of a resourceful people."

This court said in *Spring-Air Co.* v. *Ragains*, D. C., 96 F. Supp. 79, 82:

> "A device or structure, to be patentable, must be more than new and useful; it must satisfy the requirements of invention or discovery and must represent more ingenuity than the work of a mechanic skilled in the art. (Authorities cited.) An extended application of prior-art teachings, mere perfection of workmanship, a change only in size, form, strength, proportions, degree, or the substitution of equivalents doing substantially the same thing by substantially the same means, does not amount to patentable invention. (Authorities cited.) In *Sinclair & Carroll Co., Inc.*, v. *Interchemical Corporation*, 325 U. S. 327, 330, 65 S. Ct. 1143, 1145, 89 L. Ed. 1644, the court said: 'A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display "invention", "more ingenuity . . . than the work of a mechanic skilled in the art." . . . This test is often difficult to apply; but its purpose is clear. Under this test, some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee.'"

The improvement of one element in a combination of old elements does not entitle a patentee to a monopoly on the entire combination. *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545; *Bassick Manufacturing Co.* v. *R. M. Mollingshead Co.*, 298 U. S. 415; 1 *Walker on Patents*, Deller's Ed., § 41, pp. 211-218. Furthermore, an improvement to be patentable must not only be new and useful but must involve invention. 35 U. S. C. § 101; *Cole* v. *Hughes Tool Co.*, 10 Cir., (decided Sept. 15, 1954, 103 USPQ 1)—F. 2d—. Minor differences in design and construction of a patented device over the prior art, involving no new principle and accomplishing nothing more than what one skilled in the art could readily discern

do not amount to invention. *H. W. Gossard Co.* v. *Loeber's, Inc.*, 7 Cir., 114 F. 2d 166, certiorari denied 312 U. S. 680. Minor or trivial modification of a device does not show invention. *Benjamin Electric Mfg. Co.* v. *Bright Light Reflector Co., Inc.*, 7 Cir., 111 F. 2d 880. Transposition, reallocation or integration of old elements or parts does not amount to invention. *Application of Lockhart*, 38 C. C. P. A., Patents, 190 F. 2d 208, 210; *General Machinery Corporation* v. *Clearing Mach. Corporation*, 7 Cir., 104 F. 2d 553, 556; *Robinson Aviation, Inc.*, v. *Barry Corp.*, D. C., 106 F. Supp. 514, 518, 519. The mere carrying forward or extended application of an earlier idea or conception of another, involving a change only in form, proportion or degree, where the same work is performed in substantially the same way by substantially the same means, although with better results, is not invention. *Cole* v. *Hughes Tool Co., supra*, 10 Cir., 215 F. 2d 924. The mere advance in efficiency and utility is not sufficient to convert a noninventive aggregation of old elements and parts into a patentable combination. *Buffalo-Springfield Roller Co.* v. *Galion Iron Works, supra*, 6 Cir., 215 F. 2d 686.

The plaintiff's patent here in suit claims a combination for an improvement in the field of conveyer systems. This is a crowded art, as conveyer systems have long been in common use in factories, mercantile establishments, and elsewhere for the convenient and economical movement of articles in the process of manufacture and in the process of packaging, storage, and sale. In considering combination claims for an improvement in a crowded art, the court said in *Shaffer* v. *Armer*, 10 Cir., 184 F. 2d 303, 307:

> "To make sure that a monopoly is not granted for mere perfection of workmanship, the courts closely scrutinize claims to combinations for improvements in a crowded art. *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. 1, 10, 67 S. Ct. 6, 91 L. Ed. 3."

See also *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147; *Kobe, Inc.*, v. *Dempsey Pump Co.*, 10 Cir., 198 F. 2d 416; *Hollywood-Maxwell Co.* v. *Streets of Tulsa*, 10 Cir., 183 F. 2d 261.

Application for the patent in suit was filed October 16, 1939, and the patent was issued April 27, 1943. It is significant that in the course of the prosecution of this application many claims and amendments thereof, embodying old parts and elements included in the combination improvement patent ultimately issued, were rejected by the examiner, and that on review of his action as to certain claims, the board of appeals affirmed the examiner's rejection of claims 2 and 18 as amended. Claim 2 as amended and as rejected by the examiner and the board of appeals provided:

> "In a system of the character described, a trackway leading through a succession of work stations, a pallet guideway extending along the trackway, and having a longitudinal slot, a conveyer belt mounted for travel in the guideway and having abutments at spaced intervals therealong, a plurality of work mounting pallets removably mounted on the trackway for support and travel therealong, studs on the pallets extended into the guideway slot for engagement by the belt abutments for effecting the advancement of the pallets along the trackway and free for movement along the belt between successive abutments, and whereby the pallets are normally retained against lateral displacement from the trackway."

The above amended claim 2 of the application was finally rejected on the basis of prior art patents Rebstock 1,505,971, Francis 1,792,533, Baker 1,831,283, and Dahms 1,889,274. It may also be noted that claim 18 of the application, as amended, which was rejected by the examiner and by the board of appeals on the basis of Knight 1,540,021, read as follows:

> "In combination, a conveyer means leading through a work station, a work mounting pallet associated

with the conveyer means for travel therealong, and means incorporated in the conveyer means at the work station for the rotatable support of the pallet."

In support of their claim of invalidity the defendants refer to the so-called Logan conveyer, which was installed and operated in the plant of the Direct Action Stove division of the American Stove Company many years ago. Patentee DeBurgh is presumed to have had knowledge of the elements, design, and operation of this conveyer. The Logan conveyer consisted of a conveyer track, with wheel-like means consisting of rollers, supporting platforms such as crate bottoms, which moved along the conveyer; a continuously moving, power-driven chain traveling in a central slot extended the length of the conveyer; lugs on the chain spaced apart a distance substantially greater than the length of the platforms or crate bottoms, bore against the platforms or crate bottoms to push them along the conveyer. At spaced intervals on the conveyer there were so-called ball-bearing transfer plates, which might properly be called work stations, on which the platforms or crate bottoms could be rotated freely without removal from the conveyer. The crate bottoms or work-supporting platforms carrying stoves or other articles, could be passed over the ball-bearing transfer plates or work stations, or could be stopped in the station for a period dependent upon the speed of the conveyer chain and the spacing of the lugs or platform-engaging elements on the conveyer chain. As the speed of the traveling chain and the spacing of the lugs on the chain determined the speed of the crate bottoms or work platforms, the Logan conveyer could properly be referred to as a timed conveyor. Connecting with the conveyer were auxiliary or receiving lines, and crate bottoms or boxes as work-mounting supports could be transferred to or from the main line of the conveyer without manual or mechanical lifting of the work supports. The crate bottoms or other work-carrying means on the Logan conveyer illustrated, were compara-

ble to, and served the same purpose as, the so-called work pallets on the DeBurgh conveyer in suit. It may be noted that the specifications of the DeBurgh patent stated that the pallets might be circular, square, hexagonal, oblong, or any other suitable shape. The lugs on the moving chain in the Logan conveyer moved the crate bottoms along the line and illustrated and accomplished the same transportation result as the lugs on the moving belt and the pins on the bottom of the pallets in DeBurgh. The lugs on the conveyor belt in the central guideway of DeBurgh, cooperating with the centrally located pins on the pallets, kept the pallets from sideways displacement on the conveyor. This particular element to prevent sideways displacement was absent from the Logan system but is fully illustrated by Hogg 519,630, Hutton 1,448,119, Rebstock 1,505,971, and Prince 1,716,664. Furthermore, the file wrapper history of DeBurgh shows that the idea of a stud or pin on the bottom of the pallets to serve as an axis about which the pallet is rotated, was rejected as not constituting invention. The ball-bearing transfer plates on the Logan conveyor provided for free and easy rotation of the work-carrying crate bottoms and illustrated and served the same purpose as the swivel casters at the work stations in DeBurgh. At this point it should be noted that the specifications of DeBurgh provided that as an alternative for the caster supports at the work stations, ball bearings or any other form of support which would not interfere with the free and easy advancement and rotation of the pallets, might be employed. It would seem that the Logan conveyer illustrated the ideas embodied in DeBurgh, except that the crate bottoms or work-carrying platforms of Logan did not have a pin on the bottom connecting with the lug on the moving chain to prevent sideways displacement. However, this particular element was fully disclosed in the prior art cited above, and there was testimony in the present case indicating that the crate bottoms moved along the Logan conveyer

without displacement. The catalogs of the Mathews Conveyer Company published in 1930 and 1936, which were put in evidence, illustrate many of the elements and parts of the DeBurgh conveyer, and it may be noted that neither the Mathews illustrations nor the Logan conveyer was cited or considered by the patent examiner.

The use of casters for rotation of the pallet or work-carrying platform in DeBurgh is also illustrated by Fitzhenry 76,619 (not cited by the examiner), which shows the use of swivel casters to facilitate the rotation of a so-called tablet or work table, which tablet or work table served the same work-carrying purpose as the pallet in DeBurgh. The caster wheels in Fitzhenry were revolvable on their own axes and in a circular path about the axes of their spindles, and that patent states that the casters are mechanical equivalents of ball bearings.

Dahms 1,889,274 (cited by the examiner) illustrates a conveyer for the movement of articles of furniture in the process of manufacture. It describes a furniture conveyer consisting of guide tracks on which rides a movable car with supporting frame to carry an article of furniture being moved; an endless, power-driven chain for propelling the movable car; guides for the chain between the tracks; an engaging member on the driving chain to engage and propel the movable car or to disengage the car. The movable car with its supporting frame for the carrying of an article of furniture and the engaging member on the chain illustrate and serve the same purpose as the pallet and the lugs on the moving belt in DeBurgh.

Francis 1,792,533 (cited by the examiner) relates to conveyers particularly adapted for use in automobile-body factories for the movement of bodies in the process of manufacture. It provides, among other things, for a caster-supported carriage propelled by a power-driven chain in a guideway fixed to the floor, with sprocket wheels rotatably mounted on vertical axes at the points

where the direction of the guideway changes. The carriage comprises a platform mounted on swivel casters; spaced-apart pins or spurs project upwardly from the chain to engage receiving means on the carriage to propel and guide the same, and with means for automatically engaging and disengaging the carriage from the chain. Francis illustrates in reverse DeBurgh's idea of a downwardly projecting pin on each pallet to engage the lugs on the power-driven belt, whereby the pallet is guided and propelled along the trackway. In his rejection of claim 2 as amended, the examiner said: "A reversal of the positions of pin 3 and abutment 18 (fig. 3) of Francis would be suggested to anyone skilled in the art by the Dahms disclosure."

In his brief plaintiff's counsel attempts to depreciate the importance of Hogg 519,630 (cited by the examiner) as a prior art patent because of its antiquity. However, it is significant that the rather simple device described in Hogg, patented a half century ago, illustrates most of the elements or parts in the DeBurgh combination for which plaintiff is seeking a patent monopoly. Hogg relates to a conveyer device for automatically serving foods and beverages on tables and counters, but the elements, parts, and ideas illustrated in that patent would be equally adaptable to a conveyer system for carrying articles of furniture in the process of manufacture. This patent was cited as a reference by the examiner in rejecting the original claims of the DeBurgh application. Hogg illustrates a conveyer having a trackway with a power-driven endless chain located in a slot, and with rollers or wheels carrying circular and rotatable trays, the trays being provided with centrally located pendent bolts extending into the slot and removably journaled in vertical sleeves on the chain. Hogg illustrates substantially the same means as DeBurgh for removably connecting the carrying trays or pallets to a moving chain and for permitting the

carrying trays or pallets to be rotated without removal from the conveyer. The tray in Hogg is the mechanical equivalent of DeBurgh's pallet, and Hogg teaches the use of a central pin on the tray or pallet for rotatable connection with the moving chain, without permanent, fixed attachment between the pin and chain.

Rebstock 1,505,971 (cited by the examiner) illustrates a conveyer comprising spaced-apart side rails and guide members; rollers operating between said side rails; a chain running between the guide members; a platform or device resting on said rollers supporting articles being carried; and a means for connecting the article-supporting device and the moving chain.

Prince 1,716,664 (not cited by the examiner) illustrates a conveyer having a power-driven chain and a means for connecting the bottom board of the article-carrying part with the moving belt, such means comprising a pivotal projection on the bottom board and a rigid projection on the links of the moving belt.

Hutton 1,448,119 (not cited by the examiner) illustrates a trackway, a guideway, and a power-driven cable to propel a railroad coal car, with an upwardly projecting part on the cable to engage a plate or flange extending downwardly from the car.

Discussion of other prior art cited in support of defendants' contentions would only be cumulative and is unnecessary. The generic art involved in this suit is the art of conveying articles, such as pieces of furniture, through a factory in the process of manufacture. In *Buffalo-Springfield Roller Co.* v. *Galion Iron Works Mfg. Co.*, *supra*, 6 Cir., — F. 2d —, Chief Judge Simons said:

> "It is settled law beyond the need of citation that the adaptation of a machine for a new use does not entitle one to a patent if the idea of the new use is suggested by analogous art and invention may not be

perceived in the adaptation. . . . In an age of specialization it cannot be true that every differentiation from known art closes the door to its teachings and, so, entitles the adapter to a monopoly on the ground that what he has done is a new thing merely because the old instrumentality has been used for a different purpose.

"Long ago, we came to the view in *Dunham Co.* v. *Cobb*, 6 Cir., 19 F. 2d 328, that where a specialized art is merely the offspring of a more generic art it is entitled, by right of descent to the previously disclosed useful characteristic of the ancestral estate, and we have followed and applied this concept in numerous cases."

In *Mathews Conveyer Co.* v. *Palmer-Bee Co.*, 6 Cir., 135 F. 2d 73, 89, the court said:

"An old mechanism fully capable of a use not then observed, anticipates a later patent for the application of that means to the new use. Patentability cannot rest on the observation in a given device of a usefulness not before noticed; and the fact that a party did not in fact use his mechanism for a particular purpose, or even that he did not foresee that such purpose would be a useful one, is not material. *William B. Mershon & Co.* v. *Bay City Box & Lumber Co.*, C. C. Mich. 189 F. 741. Discovery of new uses for, or newly observed functions of a device, well known in the mechanical or structural arts, is not patentable invention: *Grand Rapids Refrigerator Co.* v. *Stevens*, 6 Cir., 27 F. 2d 243; and the use for which an apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent. *Dwight & Lloyd Sintering Co.* v. *Greenawalt*, 2 Cir., 27 F. 2d 823."

The DeBurgh patent in suit is a combination for an improvement in the method of utilizing factory conveyers, and combinations for improvements in a crowded art should be closely scrutinized. This patent combines an aggregation of old elements and parts from the prior art and from conveyers in prior use, with some minor un-

patentalle modifications or variations in construction and function These minor improvements in construction and function do not constitute invention. Similar results, although possibly not as satisfactory, have been accomplished in the prior art and in conveyers in prior use. The forn and arrangement of the elements and parts in a factoy conveyer system are merely matters of choice of the engineer or skilled mechanic constructing the system to neet the particular needs of a factory. *Lundell* v. *Walln Mfg. Co.*, D. C., 103 USPQ 30 (decided July 30, 1954. The patent in suit makes no substantial change in the nechanical features illustrated in the prior art and in conveyers in prior use. It is clear that a mechanic skilled n the conveyer art, and with the prior art, the Logan conveyer, and the printed publications before him, could lave created the conveyer method or mechanism described in DeBurgh. That is, the claimed invention would lave been obvious at the time of its conception to a mechanic having ordinary skill in the conveyer art. 35 U. S. C § 103. The plaintiff is claiming an aggregation of old elements or parts with some slight improvement in funcion, as a patent monopoly. The court is convinced that the patent adds little, if anything, to the total stock of knowledge in the field of conveyer systems, and dos not constitute invention.

The DeBurgh conveyer may have obtained some commercial success, but in the absence of invention, any commercial use or success it may have achieved will not create patentability. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 153.

The conveyer system described in the DeBurgh patent in suit is simple, and the question as to its patentability is plain From examination of the file wrapper, and from examination of the prior art, including the Logan conveyer and printed publications, and from objective study of the plaintiff's conveyer system, the court concludes

that all claims of the plaintiff's patent in suit are invalid because of prior art anticipation and lack of invention. The question of infringement does not require consideration, as an invalid patent cannot be infringed.

Judgment will be entered dismissing the plaintiff's original complaint filed June 30, 1950, and determining that all claims of the DeBurgh patent in suit are invalid. The defendant is entitled to recover court costs but not costs of suit.

Findings of Fact

1. The estate of patentee Albert R. DeBurgh, deceased, of which plaintiff Maria Luisa DeBurgh is executrix, is the owner of Letters Patent 2,317,675 for a "conveyer system."

2. This is a combination patent, comprising an aggregation of elements and parts old in the art of conveyer systems, with slight modifications or changes in construction and function.

3. This combination of old parts and elements with these slight modifications or changes in design and function, but without material change in result, does not represent discovery or invention within the meaning of the patent law and did not entitle plaintiff to a patent monopoly on the entire combination.

4. This patent for an improvement in conveyer systems has added little, if anything, to the total stock of knowledge in the conveyer art, but has merely brought together segments of the prior art and claims them in congregation as a monopoly. It does not represent such advance in the art as is necessary to establish invention.

5. The elements of the conveyer system described in this patent were fully disclosed and anticipated in the prior art and by conveyers in prior use, and represent only the mechanical skill of one conversant with the art.

6. The conveyer system described in the patent in suit would have been obvious at the time of the alleged invention to a mechanic having ordinary skill in the conveyer art.

7. The court finds no justification for the issuance of the patent in suit.

8. All claims of the patent are invalid.

Conclusions of Law

1. This court has jurisdiction of the parties and of the subject matter of this patent action.

2. The patent in suit is a combination patent for an improvement and, therefore, should be strictly construed.

3. The conveyer system described in the patent in suit does not represent discovery or invention within the meaning of the patent law.

4. The conveyer system described in the patent in suit was fully anticipated in the prior art and in conveyer systems in prior use, and would have been obvious to a mechanic skilled in the conveyer art, and represents only the work of a skilled mechanic.

5. All 12 claims of the patent in suit are invalid.

6. As the patent is invalid, it is not infringed.

7. The defendants are entitled to a judgment dismissing the original complaint filed June 30, 1950, and to a declaratory judgment determining that all claims of the patent in suit are invalid.

8. The defendant may recover court costs but not costs of suit.

Dated October 19, 1954.

RAYMOND W. STARR,
Chief Judge,
United States District Court for the Western District of Michigan.

JUDGMENT

As of October 19, 1954.

This matter is before the Court on complaint filed for patent infringement and the Court after having heard the proofs and allegations of the parties, the arguments of counsel and due consideration of briefs submitted, filed written opinion together with findings of fact and conclusions of law for judgment dismissing the complaint.

Therefore it is Ordered by the Court now here that all 12 claims of the patent in suit are invalid and that said claims having been held invalid by the Court now here are not considered to be infringed and that said complaint as filed on June 30, 1950 be and the same is hereby dismissed.

It is further ordered that defendant may recover court costs herein but not costs of suit.

STATUTORY AND RULE PROVISIONS CONFERRING JURISDICTION ON THE SUPREME COURT

28 U.S.C. 1254 (1)

Appeal and certiorari

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

28 U.S.C. 2101: *Supreme Court time for appeal or certiorari; docketing; stay*

(c) Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within 90 days after the entry of such judgment or decree. A justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding 60 days.

Rule 19 of the Supreme Court

Considerations governing review on Certiorari

1. A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor. The following, while neither controlling nor fully measuring the court's discretion, indicate the character of reasons which will be considered:

*** (b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter; or has decided an important state or territorial question in a way in conflict with applicable state or territorial law; or has decided an im-

portant question of federal law which has not been, but should be, settled by this court; or has decided a federal question in a way in conflict with applicable decisions of this court; or has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this court's power of supervision.

FILED
JUL 23 195
JOHN T. FEY, Cle

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1955

No. [redacted]55

MARIA LUISA DEBURGH, Executrix of the Estate of ALBERT R. DEBURGH, Deceased,
Petitioner,

vs.

KINDEL FURNITURE COMPANY, CHARLES M. KINDEL, and THE RAPIDS-STANDARD COMPANY, INCORPORATED,
Respondents.

APPELLEES' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1955

No. 816

MARIA LUISA DEBURGH, Executrix of the Estate of ALBERT R. DEBURGH, Deceased,
Petitioner,
vs.
KINDEL FURNITURE COMPANY, CHARLES M. KINDEL, and THE RAPIDS-STANDARD COMPANY, INCORPORATED,
Respondents.

APPELLEES' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

STATEMENT OF THE CASE

Appellees accept petitioner's statement of the case. Such matters set forth therein as appellees consider as inaccurate are not pertinent to the question of whether this Petition should be granted.

ARGUMENT

Argument on Questions 1 and 2.

Appellees believe Section 103 of the Patent Act of July 19, 1952 (35 *U. S. C.* 103) was intended to and did restore the standard of patentability to that defined by this Court

in 1850 in *Hotchkiss vs. Greenwood*, 52 U. S. (11 How.) 248. During the drafting of the new Patent Act, Congress had before it many definitions of invention. It is significant that Congress chose, without material change, the language of the original definition laid down by this Court in the Hotchkiss case. It is strongly persuasive if not conclusive evidence of the intent of Congress to follow the original concepts of the standard of invention. Appellees agree that the correct interpretation of Section 103 of the Patent Act of July 19, 1952 was laid down by the Second Circuit in *Lyon vs. Bausch & Lomb Optical Co.*, 224 Fed. (2d) 530, 106 USPQ 1 and by the United States Court of Appeals for the District of Columbia in *L-O-F Glass Fibers Company vs. Watson*, 228 Fed. (2d) 40, 107 USPQ 197.

Diametrically opposite interpretations of Section 103 of the Patent Act of July 19, 1952 (35 *U. S. C.* 103) is not an issue in this case. Such an issue cannot be raised except upon a factual situation incapable of resolution other than by review of the interpretations involved. The factual situation is such in this case that the result is the same under either interpretation. DeBurgh Patent No. 2 317 675 is invalid under Section 103 of the new Patent Act. It is invalid under the standard of invention laid down by this Court in *Hotchkiss vs. Greenwood*, 52 U. S. (11 How.) 248 in 1850. Accordingly, the only real matter in issue is that raised by appellant's question No. 3.

Argument on Question 3.

The standard of invention laid down in *Hotchkiss vs. Greenwood*, 52 U. S. (11 How.) 248 is best expressed in three paragraphs (page 266):

> But this, of itself, can never be the subject of a patent. No one will pretend that a machine, made, in whole or in part, of materials better adapted to the purpose for which it is used than the materials for which the old one is constructed, and for that reason better and cheaper, can be distinguished from the old one; or, in the sense of the patent law, can entitle the maufacturer to a patent.

> The difference is formal, and destitute of ingenuity or invention. It may afford evidence of judgment and skill in the selection and adaptation of the materials in the manufacture of the instrument for the purposes intended, but nothing more.

(page 267)

> * * * For, unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain knob that were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute the essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor.

In presenting its case before the Court of Appeals for the Sixth Circuit, appellees relied solely upon the *Hotchkiss vs. Greenwood* decision as authority for their position that the DeBurgh patent is invalid. Appellees established by clear and substantial evidence the public use of a conveyor built by the Logan Company of Louisville, Kentucky and installed and used for several years at the Direct Action Stove Division of the American Stove Company at Lorain, Ohio and as best exemplified by a photograph of the conveyor in actual use (Defendants' Exhibit 8, R. 263, App. p. 245a).

The function of the conveyor patented by DeBurgh and of the Logan conveyor installed at Lorain, Ohio, are identical. Only a slight structural difference exists between the two and this slight difference is taught in several prior art patents. Some of these patents were before the United States Patent Office and others were not, but all are of record in this case. While the District Court, and by adoption, the Court of Appeals for the Sixth Circuit, found, as a matter of fact, that there were modifications or changes in construction and function between the prior art structures and the patented DeBurgh conveyor, the finding was that these modifications were *slight* (Appendix to Petitioner's Brief, page 52). These changes are precisely

those which the Court held in *Hotchkiss vs. Greenwood* to be "evidence of judgment and skill in the selection and adaptation of the materials for the purposes intended but nothing more".

The differences involve the use of conventional mechanical means applied in a manner long known to the conveyor art. The persons of average skill in the conveyor art had used these same means over the years to produce the same results as those produced by the patentee, DeBurgh. The fact that the patentee initially was not acquainted with the skills already known to the conveyor art cannot transform DeBurgh's patented development into an invention. The fact that he failed to learn of these techniques and mechanical practices from the few sources he contacted in the conveyor field cannot raise DeBurgh's patented conveyor to the status of an invention. The irrefutable fact remains that the structure and function of the conveyor designed by DeBurgh was nothing more than the application of long known principles and structures. DeBurgh is not entitled to a patent for independent development or rediscovery of already known skills.

The existence of these skills and techniques long prior to the DeBurgh conveyor is a question of fact. It has been established by clear and convincing proof. The concurring decisions of the two Courts below in this matter are not in error in their fact finding of lack of invention in the DeBurgh patent. Whether the DeBurgh patent is evaluated pursuant to the standards of the decisions of this Court immediately preceding the new Patent Act or the standard established by Section 103 of the Patent Act of July 19, 1952, it is invalid for want of invention. The facts on this point are clear.

The mere fact that there are differences in structure and in function between the patented invention and the prior art and that the patented subject matter, as a whole, produces a better or more desirable product are all matters considered by this Court in the case of *Hotchkiss vs. Greenwood*. However, such differences are not enough. Section 103 of the Patent Act of July 19, 1952 (35 *U. S. C.* 103) recognizes that such differences may exist without consti-

tuting invention. To be invention, they must be of such a nature that they were not obvious at the time of the invention to a person having ordinary skill in the art to which the subject matter pertains.

Accordingly, any question that may remain in this case is not one of law but one of fact concerning the quantum of difference which exists between the prior art and the patented structure. This question of fact is concurred in by the decisions of the two lower Courts. It is a well settled rule that concurrent findings of the lower Courts on questions of fact will be accepted unless clear error is shown. *Keyes vs. Grant*, 118 U. S. 25, 6 S. Ct. 974, 30 L. Ed. 54; *Thomson Spot Welder Co. vs. Ford Motor Co.*, 265 U. S. 445, 44 S. Ct. 533. Petitioner in this case has made no showing of such error.

Accordingly, there is no question of law in controversy. Since it is immaterial whether the Courts below found the DeBurgh patent invalid on the basis of the decisions rendered by this Court prior to the Patent Act of 1952 or pursuant to the standard of invention set forth in Section 103 of the Patent Act of 1952, (35 *U. S. C.* 103) the end result is the same so far as this patent is concerned. Accordingly, the question of the standard of invention is moot and there is no reversible error which this Court can review.

Argument on Question 4.

Appellees agree that Section 282 of the Patent Act of July 19, 1952 (35 *U. S. C.* 282) was intended and does in fact create a presumption of validity for every issued patent which cannot be overcome except by clear and convincing evidence. Only the citation of pertinent prior art which was not considered by the Patent Office can overcome this presumption.

However, this question is moot since petitioner does not question that the proofs relied upon by the lower Courts are clear and sufficient. There can be no question but that these proofs are pertinent, clear and convincing. The fact that the evidence of invalidity is sufficient to overcome any

presumption of validity when evaluated by the standard established by Section 103 of the Patent Act of 1952 (35 *U. S. C.* 103) and the decision in *Hotchkiss vs. Greenwood* renders immaterial the question of whether the lower Courts afforded the presumption of validity proper weight. The result in either case is the same in this particular matter.

CONCLUSION

Conflicts in the standard of invention by which the validity of a patent is evaluated is a moot question in this case. The ultimate finding of invalidity is correct, irrespective of the standard of invention applied. Accordingly, there is no question of law which may be properly brought for review before this Court. If any question exists, it is one of fact and this Court normally does not review a question of fact, particularly where the findings are concurred in by two Courts below.

Certiorari should be denied in this case since there is no question of law properly in issue as a result of the findings of the lower Courts.

Respectfully submitted,

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IN THE

Supreme Court of the United States

October Term, 1956

No. 55

MARIA LUISA DEBURGH, EXECUTRIX OF THE ESTATE OF ALBERT R. DEBURGH, DECEASED,
Petitioner,

v.

KINDEL FURNITURE COMPANY, CHARLES M. KINDEL, AND THE RAPIDS-STANDARD COMPANY, INCORPORATED,
Respondents.

PETITIONER'S REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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In The

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October Term, 1956

No. 55

Maria Luisa DeBurgh, Executrix of the Estate of Albert R. DeBurgh, Deceased,
Petitioner,

v.

Kindel Furniture Company, Charles M. Kindel, and The Rapids-Standard Company, Incorporated,
Respondents.

PETITIONER'S REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Petitioner's Reply Argument on Questions 1 and 2

The petitioner has urged that this Court grant the petition in order to resolve a Federal question of great national importance. It has urged that in this case the Sixth Circuit interpreted §103 of the Patent Act of 1952 (35 U.S.C. 103) in a manner opposed to the interpretation of that section as given by the Second Circuit and by the United States Court of Appeals for the District of Columbia.

In appellees' brief, appellees not only agree that there are these two opposite interpretations, but surprisingly

enough indicate agreement with the interpretation of §103 as laid down by the Second Circuit in *Lyon* v. *Bausch and Lomb Optical Co.*, 224 F. 2nd 530, and by the United States Court of Appeals for the District of Columbia in *L.O.F. Glass Fibers Company* v. *Watson*, 228 F. 2nd 40, rather than with the interpretation which the Courts in the Sixth Circuit applied in the present case.

Appellees urge however, that diametrically opposite interpretations of §103 are not an issue in this case for the reason that the facts in this case are such that the result would have been the same even had the Sixth Circuit interpreted §103 in the same manner as the Second Circuit did. Appellees contend that the DeBurgh patent here involved would have been invalid under the standard of invention as set forth in §103 of the Patent Act as interpreted by the Second Circuit.

This obviously is pure surmise and conjecture on the part of appellees. Whether or not the District Court and Court of Appeals in the Sixth Circuit would have held the DeBurgh patent invalid, had they interpreted §103 in the manner that that section is interpreted by the Second Circuit, is impossible to say. It is clear, however, that they did *not* employ such interpretation.

In the present case it will be noted that the sole utterance of the Court of Appeals for the Sixth Circuit was an Order (Appendix to Petition, p. 30) affirming the Judgment of the District Court in accordance with the findings and conclusions

> "and for the reasons stated in the opinion of Judge Starr."

The "reasons" stated in the opinion of Judge Starr make the conflict between circuits amply clear. Consider for example

> "However, it has been held that the New Patent Act, 35 U.S.C. §1 et seq., did not change the tests for deter-

> mining patentability, . . .". (citing *General Motors Corp.* v. *Estate Stove Co.*, 6 Cir., 203 F. 2nd 912, 915.) (Opinion—Petition, p. 39).

And again, Judge Starr cited *In re application of O'Keefe*, 40 C.C.P.A. Patents, 202 F. 2nd 767, 771, as saying

> "The Patent Act of 1952 . . . which took effect January 1, 1953, has apparently neither raised nor lowered the standard of invention". (Opinion—Petition, p. 39).

Farther, Judge Starr cited *Interstate Rubber Products Corp.* v. *Radiator Specialty Co.*, 4 Cir., 214 F. 2nd 546, 549, to the effect that "the provisions of §103 (35 U.S.C. §103) merely codified the law".

Judge Starr thus adopted and followed in this case the proposition that the tough, stricter test of invention of some of the recent cases should be followed and that, in truth, the language of §103 does not mean what it says.

Judge Starr made this further evident in his opinion when he said:

> "The Court recognizes that decisions in recent cases indicate a clear trend toward a higher standard of invention" (Opinion—Petition, p. 37).

Thus, the Opinion of the District Court (which was adopted by the Court of Appeals in its Order) clearly did *not* state that the lower Court would have ruled the DeBurgh patent invalid even if it had followed the test of §103 as interpreted by the Second Circuit in *Lyon* v. *Bausch and Lomb Optical Co., supra.*

Mere conjecture by appellees as to what the Sixth Circuit would have ruled had it applied the Second Circuit interpretation of §103 is clearly no substitute for a judicial pronouncement. Appellees in their brief state that before the Court of Appeals they relied upon *Hotchkiss* v. *Greenwood*, 52 U.S. (11 How.) 248, and that such case

recites the standard of §103 as interpreted by the Second Circuit. The Sixth Circuit Courts, however, took the other view and the fact remains that the Sixth Circuit in this case interpreted §103 of the statute in accordance with the stricter standard of invention which it had followed in previous cases, and not in accordance with the standard which the Second Circuit believes Congress intended.

Appellees state in their brief that any question that may remain in this case is not one of law but one of fact concerning the quantum of difference which exists between the prior art and the patented structure.

This is not so and actually has no bearing on the matter of the granting of this Petition for Writ of Certiorari. The question is not one of the quantum of difference which exists between the prior art and the patented device, but that quantum of difference which under the Second Circuit interpretation of §103 would have rendered as patentable that which under the Sixth Circuit interpretation was unpatentable.

This is not a question of fact. It is, instead, a question of whether the Sixth Circuit in passing upon the facts in this case applied the statutory test in the proper manner and employed the interpretation of that test which was intended by Congress. The proper interpretation of §103 is either that given by the Sixth Circuit as applied in the present case or it is that interpretation given by the Second Circuit in *Lyon* v. *Bausch and Lomb Optical Co., supra,* and by the United States Court of Appeals for the District of Columbia in *L.O.F. Glass Fiber Co., supra.* The conflict between circuits is clear.

The matter is one of great importance to inventors, patentees, industry, and to the nation at large. It can be said without dispute that the principal question here presented as to the proper interpretation of §103 of the Patent Act is the most vital question now left undecided in

the whole body of the patent law. It has been the subject of many law journal articles and was a chosen subject discussed at the recent Judicial Conference in Washington.

The question should be resolved by this Court.

Respectfully submitted,

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